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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,031	08/16/2000	Arvind A. Raichur	30874-UT	3761

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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,031

Applicant(s)

RAICHUR ET AL.

Examiner

Peter J Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed 2/28/2005.
2. Claims 1-24 are pending in the case. Claims 1, 9, and 17 are independent claims.

Response to Amendment

3. The declaration filed on 2/28/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Jain reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Jain reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The declaration is only signed by one of the two inventors of record, thus does not provide evidence that the inventory entity conceived the claimed invention prior to March 9, 1999. Also, the declaration notes that Exhibit A was submitted by inventor Becky D. Raichur to co-inventor Arvind A. Raichur prior to March 9, 1999, thus it does not prove co-inventor Arvind A. Raichur worked on conception of the claimed invention prior to March 9, 1999. Furthermore, to show that Exhibit A proves conception of the claimed invention, the document to be mapped out by Applicant to show specific support for each of the limitations of the claimed invention. For these reasons, the Rule 131 Declaration submitted by Applicant does not prove conception of the claimed invention. Please see MPEP 2138.04 for more information on proving conception.

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The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Jain reference to either a constructive reduction to practice or an actual reduction to practice. A portion of MPEP 2138.06 states:

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....").

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Specifically, the Examiner would like to note that the a simple statement of diligence is not enough to prove diligence because it is not a showing, but a mere pleading. Also in this cited section, the MPEP notes that as little as a two day period of inactivity has been held to be fatal for proving diligence. The MPEP also notes that the period during which diligence is required must be accounted for must be accounted for by either affirmative actions or acceptable excuses. Thus, Applicant must submit evidence proving diligence (underlined for emphasis) for the critical time period from March 9, 1999 to August 16, 1999. For these reasons, Applicant's Rule 131 Declaration fails to prove diligence during the critical period.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain, US 6,480,853 B1 filed 3/8/1999 in view of Chen, US 6,349,307 B1 filed 12/28/1998.

Regarding independent claims 1, 9, and 17, Jain teaches a search engine server which creates a custom search index to hypertext transmission protocol pages using a user's bookmarks in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. Bookmarks employ a hierarchical plurality of topic categories to organize the stored links. Jain does not teach permitting a user to specify any subset of the plurality of topic categories and adding to a hypertext transmission protocol page controlled by the user link information permitting

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execution of searches of the index server in any category of the subset but only of categories of the subset.

Chen does teach permitting a user to specify any subset of a plurality of topic categories and adding to a hypertext transmission protocol page controlled by the user link information permitting execution of searches of an index server in any category of the subset but of categories in the subset in col. 9 line 47 – col. 10 line 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Chen into Jain to have created the claimed invention. It would have been obvious and desirable to used the topic category selection search of Chen to have modified and improved Jain so that the user could have automatically filtered out topic categories for which they know no useful results would have been obtained. It would have allowed the user more control in the search process and enabled a better search result.

Regarding dependent claims 2, 10, 18, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. A user can propose addition of a hypertext transmission protocol page to the bookmarks in conjunction with one or more categories of the subset and automatically adding the proposed page to the index server when the bookmarks URLs are uploaded to the index server. The index is private for the user and thus other users will not search the proposed page, even if using the search engine server to search other topic categories.

Regarding dependent claims 3, 11, 19, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. Jain does not teach verifying a that a uniform resource locator address for the

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proposed page is valid and that the proposed page is not already indexed under the proposed one or more categories. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Jain in view of Chen so that it could have verified proposed pages and proposed categories so that the index would not have been redundant. This would have made the search engine more efficient.

Regarding dependent claims 4, 12, 20, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. Jain does not teach that the custom created search index is sharable with other users. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Jain in view of Chen to have allowed other users to have searched the proposed page when searching one or more of the proposed one or more categories to have allowed the search index users to have shared their proposed pages and increased the breadth of their searches by borrowing the URL index additions of other users.

Regarding dependent claims 5, 13, 21, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. A user can rename one or more categories of a subset of bookmarks. Therefore, Jain teaches allowing the user to rename one or more categories of the subset as it will appear on the hypertext transmission protocol page controlled by the user.

Regarding dependent claims 6, 14, 22, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. A user can rearrange one or more categories of a subset of bookmarks. Therefore,

Jain teaches allowing a user to rearrange hierarchicalization of one or more categories of the subset as it will appear on the hypertext transmission protocol page controlled by the user.

Regarding dependent claims 7, 15, 23, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. Chen teaches permitting a user to specify any subset of a plurality of topic categories in col. 9 line 47 – col. 10 line 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Chen into Jain to have created the claimed invention. It would have been obvious and desirable to used the topic category selection search of Chen to have modified and improved Jain so that the user could have automatically filtered out topic categories for which they know no useful results would have been obtained. It would have allowed the user more control in the search process and enabled a better search result.

Regarding dependent claims 8, 16, 24, Jain teaches using personal bookmarks to create a custom search index in fig. 3 and 5, col. 2 line 55 – col. 3 line 12, col. 5 lines 58-64, and col. 6 lines 4-12. Chen teaches permitting a user to specify any subset of a plurality of topic categories in col. 9 line 47 – col. 10 line 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Chen into Jain to have created the claimed invention. It would have been obvious and desirable to used the topic category selection search of Chen to have modified and improved Jain so that the user could have automatically filtered out topic categories for which they know no useful results would have been obtained. It would have been obvious and desirable to have dynamically updated the link information to correspond to the new subset. It would have allowed the user more control in the search process and enabled a better search result.

Response to Arguments

6. Applicant's arguments filed 2/28/2005 have been fully considered but they are not persuasive. The Rule 131 Declaration submitted by Applicant is ineffective to overcome the prior art reference of Jain. Thus, the Examiner maintains the rejections set forth in the previous Office Action.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
4/18/2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER